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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,152	04/27/2001	Markus Stolze	SZ999024US1/954-010121-US	1785

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EXAMINER

MCCLELLAN, JAMES S

ART UNIT PAPER NUMBER

3627

DATE MAILED: 02/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/844,152

Applicant(s)

STOLZE ET AL.

Examiner

James S McClellan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-10 and 15-28 is/are rejected.
- 7) ☒ Claim(s) 3 and 11-14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 April 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Preliminary Amendment

1. Applicant's submittal of an amendment was entered on April 27, 2001, wherein:

claims 1-28 are pending;

claims 4, 5, 7, 9-11, 13, 15, 17, 19-23, 26, and 27 have been amended; and

claim 28 has been added.

Claim Objections

2. Claims 1, 23 and 24 are objected to because of the following informalities: in claim 1 (lines 10 and 11), claim 23 (line 2) and claim 24 (lines 11 and 12) the phrase "a said rule" or "a said question" is used. It appears that "a said rule" should be replaced with --said rule--. Appropriate correction or clarification is required. Additionally, all other occurrences of "a said" in the claims should be clarified.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
4. Claims 27 and 28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim(s) are directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention. See M PEP §2173.05(p) II or *Ex Parte Lyell*, 17 USPQ2d 1548

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(B.P.A.I., 1990). In this case, it is unclear in claims 27 and 28 if Applicant intends to claim a process or an apparatus. Claims 27 and 28 appear to be directed to both statutory classes of invention, wherein an apparatus claim is dependent upon a method claim. Clarification and correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 9, 22, 27 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation "the weight" in line 1. Claim 22 recites the limitation "said feature-based filtering" in line 3. There is insufficient antecedent basis for this limitation in the claim.

In addition to rejection set forth above under 35 U.S.C. § 101, claims 27 and 28 are indefinite because it is unclear what statutory class of invention Applicant intends to claim. Is claim 27 a process or an apparatus? Is claim 28 a process or an apparatus? Clarification and correction is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2, 4-6, 10, 17-20, and 22-28 rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,070,149 (hereinafter "Tavor").

Regarding **claim 1**, Tavor discloses a method of selecting, in an electronic product catalog system, a question to be presented to a user of the system (see column 5, lines 56-60) to assist identification of a suitable product from a set of potentially suitable products according to the user's needs, the question being selected from a group of questions stored in said system (see column 11, lines 42-44, "All questions, which are stored in memory"), which method comprises: processing product data stored in said system, defining features of products in said set and product scores associated with respective products in said set (see column 12, lines 22-26), and rule data stored in said system (see column 5, lines 56-65, "rules base"), defining rules relating answers associated with said questions (see paragraph bridging columns 5-6) to product features constraints (see column 8, lines 36-53, for example "carat" size is a product feature), to calculate question scores (either True or False; see paragraph bridging columns 5-6) such that the question scores for each question is dependent on one of (a) the product scores of any products excluded from said set if said rule relating to an answer associated with that question is effective and (b) the product scores of any products retained in said set if said rule relating to an answer associated with that question is effective (see column 6, lines 10-15);, and selecting the question to be presented to the user in dependence on said question scores (see column 6, lines 5-15); [**claim 2**] the question score is dependent on one of the product is either excluded or retained (see column 6, lines 5-15); [**claim 4**] the

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question score for each question is dependent on only (b) (see column 6, lines 5-15; **[claim 5]** said product scores are predetermined in said system for respective products (see column 4, lines 1-9); **[claim 6]** product scores are associated with user needs and selecting from the group of product scores for a product corresponding the to the user needs (see column 9, lines 50-60); **[claim 10]** calculating the product scores associated with respective products in dependence on values assigned to product features by said rules (see column 6, lines 5-15); **[claim 17]** said set of potentially suitable products is determined by previous interaction of the user with said system (see column 8, lines 36-53); **[claim 18]** defining said set of potentially suitable products from a feature-based filtering component (see column 21, lines 33-40) **[claim 19]** supplying the selected question for display to the user (see Figure 3 and column 8, lines 36-53); **[claim 20]** supplying at least some answers associated with the selected question for display to the user (see Figure 3 and column 8, lines 36-53; also see column 11, lines 48-56); **[claim 22]** determining if any of the rules are effective based on the user's answer and applying feature-based filter (see column 6, lines 5-15) **[claim 23]** prior to selecting a question to be presented to a user: generating question data, comprising said group of questions, and storing the question data in said system; generating catalog data, including said product data for products in said set, defining features of catalog products and product scores associated with respective products, and storing the catalog data in said system; and generating said rule data and storing the rule data in said system (see columns 5-6).

Regarding **claims 24-26**, Tavor discloses an apparatus (see Figure 1) for selecting a question to be presented to user as set forth above in the analysis of process claim (claim 1).

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Regarding **claims 27 and 28**, as best understood, Tavor discloses a computer processor and storage medium for a computer program element that performs the method of claim 1.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7, 8, 15, 16, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tavor in view of U.S. Patent No. 6,633,852 (hereinafter "Heckerman").

Regarding **claims 7, 8, 15, 16, and 21**, Tavor fails to expressly disclose determining a probability of a product being suitable for the user and ordering the answers by rank.

Heckerman discloses determining a probability of a product being suitable for the user (see column 12, lines 35-64).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Tavor with product probability determinations as taught by Heckerman, because determining the probability that a product is desirable decreases the time required to fine tune the search for the user.

Allowable Subject Matter

11. Claims 3, and 11-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. Claim 9 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Stratmann is cited of interest for disclosing a method for assisting individuals in decision making process.

Robinson is cited of interest for disclosing an automated collaborative filtering system.

Greef et al. is cited of interest for disclosing an electronic catalog system and method for enhanced feature-based search.

Westrope et al. is cited of interest for disclosing a system for an interactive computerized catalog.

Chislenko et al. is cited of interest for disclosing a method for item recommendation using automated collaborative filtering.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

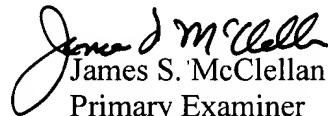
Any response to this action should be mailed to:

Commissioner of Patent and Trademarks
Washington D.C. 20231

or faxed to:

(703) 872-9306 (Official communications) or
(703) 746-3516 (Informal/Draft communications).

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.


James S. McClellan
Primary Examiner
A.U. 3627

jsm
February 6, 2004